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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,118	11/09/2000	Rocco A. De Lillo	10722.270	6442

27383 7590 07/29/2003
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EXAMINER

LEE, BENNY T

ART UNIT	PAPER NUMBER
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2817

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER
	16

DATE MAILED:

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 22 April 2003 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire Three (3) month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-4, 6-8, 10, 11, 13-15, 17-19, 21-26, 28-30, 32-41 are pending in the application.
Of the above, claims 13-15, 17-19, 21, 22 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-4, 6-8, 10, 11; 23-26, 28-30, 32, 33; 34-41 are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-4, 6-8, 10, 11; 13-15, 17-19, 21, 22; 23-26, 28-30, 32, 33; 34-41 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☒ The corrected or substitute drawings have been received on 22 April 2003. These drawings are ☒ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☒ The proposed drawing correction, filed 22 April 2003, has been ☒ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections **MUST** be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

Art Unit: 2817

Claims 13-15, 17-19, 21, 22 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 10.

The disclosure is objected to because of the following informalities: Page 1, line 28 and page 2, line 1, contrary to applicants' assertion, it should be noted that "long packaging" has not been amended and thus this objection is repeated. In the replacement paragraph to page 13, line 17, fourth line therein, note the "∴" should be rewritten as just --:--.

Appropriate correction is required.

Regarding the description of reference labels with respect to certain drawing figures, applicants' comments have been considered and found to be persuasive. None the less, the examiner suggests that applicants' insert a statement into the specification (e.g. prior to the detail description) that explicitly indicated that like features in different drawing figures are designated by like or same reference labels to avoid any misunderstanding.

The drawings are objected to because of the following: In figs. 13, 14, note that the single curves in these drawing figures should be additionally amended to include "P" designations much in the manner as those designated in figs. 15, 16, 17. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the embedded active elements (e.g. cls

Art Unit: 2817

11, 33, etc) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The recitation that “at least one surface” is “adhered to ceramic” (e.g. cls 10, 32, etc) does not appear to have been disclosed in the original specification.

Claims 23-26, 28-30, 32, 33; 34-41 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 23, 24, note that the added limitation of the “conductive layers” does not appear to be explicitly disclosed in the original specification and thus has to be treated as “new matter”.

However, if applicants’ do not believe that the cited subject matter is “new matter”, than an appropriate explanation is required including pointing out where in the original specification support for the limitation in question can be found.

Art Unit: 2817

Claims 1-4, 6-8, 10, 11; 32; 34-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 35, note that it is unclear what is the full scope encompassed by the phrase "different dielectric properties". Note from the specification (i.e. p 12, ls 1-10) that it appears that the only dielectric property which is disclosed to be different is the dielectric constant. It should be noted that no other "properties" (other than dielectric constant) appear have been identified as "different" ^{and the the claims' full scope} can not be clearly ascertained.

In claim 32, ^enot that "comprises adhered to ceramic" (as amended) is vague in meaning. Clarification is needed.

In claim 34, 8th paragraph, note that "a metal layers" is of inconsistent tense; thereby rendering indefinite whether a single layer or plural layers was intended.

Claim 23, last paragraph, is found objectionable since "forms should be rewritten as -- comprises-- (e.g. see cl 34) and "coupline" should correctly be --coupling--.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 23-26, 28-30; 34, 36-38, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiki in view of Juskey et al (both of record) for reasons of record.

With respect to the limitation that the conductive via connecting the metal layers to terminals being the same metal as the metal layers, Fujiki's via layers (D, E) can be formed as a

Art Unit: 2817

paste or a plating (like applicants'). Although, the metal of the paste or plating of the via is unspecified, those of ordinary skill in the art recognized that using a metal which is the same as the metal layers would have been desirable and thus would have provided an obvious optimization of metal used to form the conductive layers and vias of the device.

With respect to the limitation of claim 41, it is evident from Fig. 2 of Fujiki that ground layers (2b, 4b, 6b) substantially cover the entire surfaces of the substrate except for cut-outs where the vias (D, E) are isolated from the ground plane layers, much in the same way applicants ground layer cover the entire substrate in the inventive device.

Applicant's arguments filed 22 April 2003 have been fully considered but they are not persuasive. With respect to claims 23, 34, applicants' have asserted that Fujiki uses conductive paste as its' "via" material and as such is a completely different material. Accordingly, notwithstanding the "new matter" issue raised above, the combination of references does indeed meet this aspect of the claims, as amended. As noted in the above statement of rejection, forming the conductive layer (i.e. spiral layer) and the conductive vias with a "same metal" would have been considered an obvious desirable optimization of metal material. Moreover, it should be noted that these claims merely require the layers and via be of a "same metal" and not necessarily that both the conductive layers and vias be of the same "material", and thus conductive paste of a metal which is the same as the metal as the conductive layer (and not of the same material) is what needed to have met the above claims.

Art Unit: 2817

With respect to the limitations in newly added claim 41, applicants' have argued that the ground planes in Fujiki do not extend over the entire substrate surface except for cut-outs for the conductive vias. Contrary to applicants' assertion, it is evident from Fig. 2 of Fujiki that ground plane layers (sb, 4b, 6b) do indeed cover the respective substrate surface except for cut-outs for via regions (D, E) much in the same manners as in applicants' invention and thus meets this aspect of the claim.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2817

Claims 23, 28, 30, 32, 33; 34, 36, 38-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4; 6-8; 10-13; 14-18 of copending Application No. 114711. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the co-pending application recite substantially the same subject matter as recited in the above claims of this application and thus the co-pending application claims “anticipate” the claims of this application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

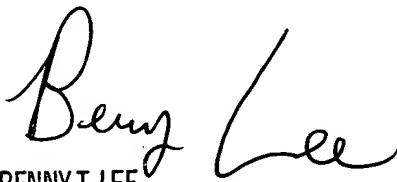
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2817

In view of the papers filed 19 September 2002, the inventorship of this nonprovisional application has been changed by the deletion of Joseph McAndrew as an inventor.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and USPTO PALM data to reflect the inventorship as corrected.

Any inquiry concerning this communication should be directed to Benny Lee at telephone number (703) 308-4902.


BENNY T. LEE
PRIMARY EXAMINER
ART UNIT 2817

B LEE/pj

07/24/03